

REMARKS

Applicants submit this Amendment in reply to the Office Action mailed June 13, 2005.

At the outset, Applicants amend claims 33, 40 and 47 by changing “studs” to a “plurality of studs” to maintain proper antecedent basis. Applicants also amend claim 33 to recite “an external surface of the tread band” and “one of the respective seats” to maintain proper antecedent basis. Claim 33 has been further amended to recite “wherein, the predefined degree of clearance is such that during the step of opening the mold, the plurality of metal studs maintain the substantially-perpendicular arrangement.”

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 33, 40, 47. In particular, support for the phrase “wherein, the predefined degree of clearance is such that during the step of opening the mold, the plurality of metal studs maintain the substantially-perpendicular arrangement” can be found, for example, on page 18, lines 1-15 of the Specification and shown in Figure 2b.

In the Office Action dated June 13, 2005, the claims 33-34, 40-41, and 47-48 were rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 2,770,013 to Crooker (“Crooker”). Claims 33-34, 40-41, and 47-48 were also rejected under 35 U.S.C. § 103 (a) as being unpatentable over Crooker and optionally in view of U.S. Patent No. 5,234,326 to Galli et al (“Galli”). In addition, claims 35-37, 42-44, and 49-51 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Crooker, optionally Galli, and further in view of U.S. Patent No. 2,121,956 to Eger (“Eger”). Claims 35-39, 42-46, and 49-53 were further rejected under 35 U.S.C. § 103 (a) as being unpatentable over Crooker, optionally Galli, and further in view of U.S. Patent No. 2,808,621 to Torrey (“Torrey”).

Applicants respectfully traverse the 35 U.S.C. § 102 (b) rejection of claims 33-34, 40-41, and 47-48 and the 35 U.S.C. § 103 (a) rejection of claims 33-34, 40-41, and 47-48.

Independent claims 33, 40 and 47 have been rejected under 35 U.S.C. § 102 (b) as being anticipated by Crooker and under 35 U.S.C. § 103 (a) as being unpatentable over Crooker optionally in view of Galli. As discussed in greater detail below, neither reference taken alone or in combination, anticipates or renders obvious proposed amended claim 33, and claims 40 and 47. Specifically Crooker at least fails to teach the limitations of “wherein, the predefined degree of clearance is such that during the step of opening the mould, the plurality of metal studs maintain the substantially-perpendicular arrangement,” (claim 33), “the plurality of metal studs are not subjected to any flexural stress” (claim 40), and “the plurality of metal studs are not subjected to traction caused by friction against the seats” (claim 47).

At page 3 of the Office Action, the Examiner argues that Crooker discloses a clearance in an embodiment which utilizes a magnet to hold a stud in place. *See* Figure 8, column 3, lines 43-56. In that embodiment, Crooker describes bore 48 as having a conical recess 50 formed in its inner end face. As Crooker discusses, “[i]n use, the end of the stud 51 is inserted into the sleeve 47 until the tip engages the magnet 49” (emphasis added). *See* column 3, lines 51-53. Moreover, as shown in Figure 8, there is no clearance between conical recess 50 and the tip of stud 51. Accordingly, Crooker necessarily fails to teach “a predetermined degree of clearance, which is sufficient to allow the plurality of metal studs to keep their orientation perpendicular to the tread band,” (emphasis added) as recited in claim 33.

The fact that Crooker describes the studs as being “releasably held” does not necessitate a clearance. The other embodiments of Crooker, which describe studs that are frictionally engageable with the sidewalls (column 2, line 46) are also described as being “readily

removable” (column 1, 32). Additionally, the embodiment shown in Figure 6, alleged by the Examiner to show a clearance (*see* Office Action, page 3) consists of a leaf spring 44 in direct contact with a stud 45, but does not teach the claimed “clearance.”

In rejecting claims 33-34, 40-41, and 47-48 under 35 U.S.C. § 103 (a) as being unpatentable over Crooker and optionally in view Galli, the Examiner relies on Galli for allegedly teaching the claimed predefined degree of clearance. *See* Office Action, page 3. Claim 33, however, recites that the predefined degree of clearance “exists between lateral portions of each of the plurality of metal studs and respective seats.” Moreover, as noted above, the predefined degree of clearance is such that “during the step of opening the mould, the plurality of metal studs maintain the substantially-perpendicular arrangement.” Accordingly, the predefined degree of clearance is defined in relationship to features of each stud. Thus, Galli, which is silent as to providing any studs whatsoever in a tire, cannot teach or suggest the claimed predefined degree of clearance.

The Examiner further contends that “the studs must inherently maintain a substantially perpendicular arrangement” and that the “a predefined degree of clearance” of claim 33, the studs not being “subjected to any flexural stress” as recited in claim 40, and the studs not being “subjected to traction caused by friction against the seats,” as recited in claim 47 are inherently met by Crooker. *See* Office Action, page 3 (emphasis added).

Applicant respectfully notes, however, that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *See* MPEP § 2112; *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666

F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Here, the Examiner asserts that “the studs must inherently maintain a substantially perpendicular arrangement as claimed since Crooker teaches that the studs are held in position during curing and shows the studs being perpendicular to the tread surface in figure 1.” *See* Office Action, page 3. However, Crooker is silent as to opening the mould, and is thus certainly silent as to the arrangement of the studs during the opening of the mould. With respect to the limitations “a predefined degree of clearance exists between lateral portions of each stud and respective seat,” (claim 33), “the studs are not subjected to any flexural stress” (claim 40), and “the studs are not subjected to traction caused by friction against the seats” (claim 47), the Examiner merely states that the claims are inherently met by Crooker since the magnet “releasably holds the studs.” *See* Office Action, page 3.

Moreover, since neither Crooker nor Galli teaches the claimed predetermined degree of clearance, the studs on Crooker would necessarily be subjected to flexural stresses and traction. Accordingly, even if the teachings of Crooker were combined with Galli, as proposed by the Examiner, the applied references would still fail to teach the limitations of “wherein, the predefined degree of clearance is such that during the step of opening the mould, the plurality of metal studs maintain the substantially-perpendicular arrangement,” (claim 33), “the plurality of metal studs are not subjected to any flexural stress” (claim 40), and “the plurality of metal studs are not subjected to traction caused by friction against the seats” (claim 47). In view of the

above-described shortcomings of Crooker and Galli, claims 33, 40, and 47 are allowable over the applied references. Accordingly, claims 33, 40 and 47 are allowable over the applied references and the rejections under 35 U.S.C. § 102 (b) and § 103(a) should be withdrawn. In addition claims 34, 41, and 48 are allowable at least due to their corresponding dependence from claims 33, 40, and 47.

Claims 35-37, 42-44, and 49-51 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Crooker, optionally Galli, and further in view of Eger. Claims 35-39, 42-46, and 49-53 were further rejected under 35 U.S.C. § 103 (a) as being unpatentable over Crooker, optionally Galli, and further in view of Torrey. Applicants respectfully traverse these rejections.

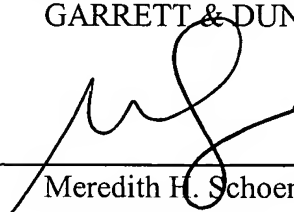
Eger teaches a tire with cup-shaped metallic inserts 6 which are tightly fit into the tire. *See* Specification column 3, lines 25-40. Torrey teaches a tire in which friction elements 17 are placed in the tire mold and are attracted to the magnets 16. However both fail to teach the limitations of “wherein, the predefined degree of clearance is such that during the step of opening the mould, the plurality of metal studs maintain the substantially-perpendicular arrangement,” (claim 33), “the plurality of metal studs are not subjected to any flexural stress” (claim 40), and “the plurality of metal studs are not subjected to traction caused by friction against the seats” (claim 47). Eger and Torrey, therefore, both fail to overcome the above noted deficiencies of Crooker and Galli. Accordingly, claims 35-39, 42 -46, and 49-53 are allowable at least due to their corresponding dependence on claims 33, 40 and 47.

If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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